

Amendment and Response Under 37 C.F.R. 1.116

Applicant: Andrew M. Spencer

Serial No.: 10/689,157

Filed: October 20, 2003

Docket No.: 10013891-1

Title: REMOVABLE INFORMATION STORAGE DEVICE THAT INCLUDES A MASTER ENCRYPTION KEY AND ENCRYPTION KEYS

REMARKS

The following remarks are made in response to the Final Office Action mailed June 13, 2008. Claims 16-26 have been withdrawn from consideration. With this Response, claim 28 has been amended and claims 27 and 30 have been canceled. More specifically, claim 28 has been amended to incorporate the subject matter of claim 30, effectively placing claim 30 in independent form. Thus, the Amendments presented herein do not raise new issues requiring additional consideration and/or search.

Claims 1-15, 28 and 29 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 102

Claim 27 was rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Mihm et al. (US 2003/0236983 A1). Without acquiescing to the reasoning set forth in the rejection, claim 27 has been deleted to move the application to allowance.

Claim Rejections under 35 U.S.C. § 103

Claims 1-15 and 28-30 are rejected under 35 U.S.C. 103(c) as being unpatentable over Mihm et al. (US 2003/0236983 A1), and further in view of Fujita (US 6,947,318 B1). Applicant respectfully traverses these rejections.

It is well accepted that each claim element must be considered. MPEP 2143.03. Among other things, claim 1 includes

a non-volatile magnetic memory configured to store encryption keys which have been encrypted using the master encryption key and to store data which has been encrypted using the encryption keys

As noted in Applicant's previous responses, the Final Office Action fails to identify a disclosure or suggestion in either Mihm or Fujita regarding this claim element. The Final Office Action only appears to address the EUID stored in the flash memory 162 shown in Figure 1 of Mihm. In this regard, the Final Office Action cites paragraphs 0034 and 0035 of Mihm. However, these cited portions of Mihm do not address storing data encrypted using the EUID in the flash memory 162. Regarding use of the EUID, paragraph 0035 of Mihm simply states,

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the EUID 162 may be used to secure communications with the service provider or some other entity, for example by authenticating the user or the device and/or another party to the transaction.

Thus, there is no teaching or suggestion identified in the Final Office Action of storing anything other than the EUID in the flash memory 160 of Mihm. Since the combination of Mihm and Fujita fails to disclose or suggest each claim element of claim 1, the Final Office Action fails to establish *prima facie* obviousness of claim 1 and the claims dependent thereon.

Claim 28 has been amended to incorporate the elements of claim 30, effectively placing claim 30 in independent form. As such, claim 28 includes,

reading the encrypted encryption keys from a magnetic random access memory;
reading a master encryption key from a first non-volatile memory;
decrypting each one of the encryption keys using the master encryption key
encrypting data using the encryption keys; and
writing the encrypted data to the magnetic random access memory.

In rejecting claim 30, which originally included the elements regarding writing encrypted data to the magnetic random access memory (which also stores the encrypted encryption keys), the Final Office Action simply alleged that it had “limitations similar to those of claim 28, thus they are rejected with the same rationale as applied against claim 28 above.” Final Office Action at p. 9.

Claim 30 originally depended from claim 28. As such, it had no “limitations similar to those of claim 28” from which it depended. 35 USC 112, paragraph 4 provides,

a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers

Thus, claim 30 included each of the limitations of claim 28, as well as further limitations. The Final Office Action thus failed to consider the elements of claim 30, which have now been incorporated into claim 28. As such, the Final Office Action failed to establish *prima facie* obviousness of claim 28 and claim 29 dependent thereon.

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CONCLUSION

In view of the above, Applicant respectfully submits that all of the pending claims are in form for allowance and are not taught or suggested by the cited references. At a minimum, the amendments simply issues for appeal. As such, Applicants respectfully submit that the amendments presented herein are proper for entry under 37 CFR 1.116.

In view of the amendments and remarks presented herein, Applicants respectfully request reconsideration and withdrawal of the rejections and allowance of the claims.

No fees are believed to be required under 37 C.F.R. 1.16(h)(i). However, if any such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Mark L. Gleason at Telephone No. (612) 767-2503, Facsimile No. (612) 573-2005 or Manisha Chakrabarti at Telephone No. (630) 898-3274, Facsimile No. (630) 898-7247. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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